

REMARKS

By this Amendment, Applicants propose to amend claims 52, 54, 56, 60, 109, and 110, and add new claims 116-119. Support for the claim amendments and for new claims can be found, for example, at least in Figs. 1A-1E, 2, 4, 10A-10C, 14A and 14B, and the corresponding written description of those figures.

In the final Office Action, currently pending claims 52-57, 60-63, and 109-113 were rejected under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent No. 6,092,526 to LaFontaine et al. ("LaFontaine"), and claims 114 and 115 were rejected under 35 U.S.C. § 103(a) as being unpatentable over LaFontaine in view of U.S. Patent No. 6,190,353 to Makower et al. ("Makower").

Of the rejected claims, claims 52, 60, and 110 are independent. Claims 52 and 60 are each directed to a method of placing a conduit in the wall of a patient's heart. Claim 52 recites, among other things, "from a position exterior to a coronary vessel, passing the support member first through an exterior wall of a coronary vessel and then through a wall of the patient's heart." Claim 60 recites "passing the support member from a position exterior to a coronary vessel through an exterior wall of the coronary vessel . . . wherein the support member passes through the exterior wall of the coronary vessel prior to placing the support member in the wall of the patient's heart."

LaFontaine does not disclose the above-quoted features of claims 52 and 60. More specifically, LaFontaine discloses various percutaneous procedures, for example, in Figs. 3, 4, 5A, and 5B, in which devices are passed endovascularly to the heart chamber and into a heart wall. These embodiments do not disclose or otherwise suggest either "from a position exterior to a coronary vessel, passing the support

member first through an exterior wall of a coronary vessel and then through a wall of the patient's heart," as recited in claim 52, or "passing the support member from a position exterior to a coronary vessel through an exterior wall of the coronary vessel . . . wherein the support member passes through the exterior wall of the coronary vessel prior to placing the support member in the wall of the patient's heart," as recited in claim 60.

Regarding Figs. 5E and 5F of LaFontaine, relied on by the Examiner in the Office Action, the various devices in those embodiments pass first through a heart wall 86 and then through the vein 142 and vessel wall 92. Thus, those embodiments of LaFontaine also do not disclose or otherwise suggest the above-quoted features of claims 52 and 60. Although in Figs. 5G-5J, LaFontaine shows passing guidewires 160 and 162 separately through an exterior wall of a coronary vessel, the catheter 170 and burr 172 are advanced endovascularly into the heart chamber over guidewire 162 and not first through the exterior wall of the coronary vessel. There is no disclosure in the embodiment of Figs. 5G-5J of LaFontaine regarding positioning a conduit within a wall of the heart, as is further required by claims 52 and 60.

LaFontaine therefore fails to disclose or otherwise suggest the above-noted recitations in claims 52 and 60. For at least this reason, therefore, the claim rejections based on LaFontaine should be withdrawn, and claims 52-57, 60-63, 109, and 116-119 should be allowed.

Regarding the rejection of claims 110-113 based on LaFontaine, that rejection should be withdrawn because LaFontaine does not teach or otherwise suggest a method including, among other things, "inserting the sheath through an outer surface of a heart wall of the heart chamber at a location offset from the coronary vessel," as

recited in independent claim 110. Thus, the Section 102 rejection of claims 110-113 based on LaFontaine should be withdrawn.

Claims 114 and 115, which depend from claim 110, were rejected under 35 U.S.C. § 103(a) as being unpatentable over LaFontaine in view of Makower. Makower, however, does not cure the above-noted deficiency of LaFontaine. Indeed, the Examiner has not asserted otherwise in the Office Action, but instead relied on Makower for its alleged disclosure of “a stent with anastomosis end having flange for [securing] the prosthesis to vessel walls.” For at least this reason, therefore, the Section 103 rejection based on LaFontaine and Makower should be withdrawn.

Claims 53-57, 61-63, 109, and 111-119 depend from one of claims 52, 60, and 110, respectively, and therefore are allowable for at least the same reasons each of those respective claims is allowable. In addition, at least some of those dependent claims recite unique combinations and/or features that are not taught or suggested by the prior art, and therefore at least some of those claims also are separately patentable.

Applicants respectfully request that this Amendment under 37 C.F.R. § 1.116 be entered, placing claims 52-57, 60-63, and 109-119 in condition for allowance.

Applicants respectfully point out that the final Office Action presented some new arguments as to the application of the art against Applicants' claims. It is respectfully submitted that the entering of this Amendment would allow the Applicants to reply to the final rejections and place the application in condition for allowance.

Finally, entry of this Amendment would place the application in better form for appeal, should the Examiner dispute the patentability of the pending claims.

Applicants therefore request the entry of this Amendment, the withdrawal of the outstanding rejections, and the timely allowance of the pending claims.

If there is any fee due in connection with the filing of this Amendment that is not otherwise accounted for, please charge the fee to our Deposit Account No. 06-0916.

Respectfully submitted,

FINNEGAN, HENDERSON, FARABOW,
GARRETT & DUNNER, L.L.P.

Dated: May 20, 2005

By: Susanne T. Jones
Susanne T. Jones
Reg. No. 44,472